

1 Remarks

2 Amendments to the Claims

3 Claims 6 and 12 have been amended as provided above. Specifically, claim
4 6 has been amended to recite "a first website" and "a second website" in order to
5 correct a lack of antecedence issue with respect to claim 7, which depends
6 therefrom. Claim 12 has been amended to recite "first and second" websites in order
7 to correct lack of antecedence issues with respect to claims 12-20. Also, claim 12
8 has been amended to clarify information stored at the first and second websites as
9 "user" information, and to further clarify the capabilities of the software application
10 recited thereby. Support for these respective amendments is found at least at page
11 3, line 4 to page 7, line 30 of the Specification as originally filed. No new matter has
12 been added by way of the amendments to the claims.

13
14 Objections to the Claims

15 Claims 7 and 12-20 have been objected to because the following terms lack
16 antecedent basis: Claim 7, "said first website"; and Claim 12, "said websites" (page 2
17 of Office action). Claims 6 and 12 have been amended as provided above in order
18 to address these respective objections. The Applicant respectfully requests that the
19 objections to claim 7 and 12-20 (as respectively amended) be withdrawn.

20
21 Rejection of Claims under 35 U.S.C. § 103

22 Claims 1-20 have been rejected under 35 U.S.C. § 103(a) as being
23 unpatentable over U.S. Patent No. 6,199,079 ("Gupta").

24 The Applicant respectfully disagrees that claims 1-20, as respectively
25 amended, are unpatentable over Gupta.

As a starting point, MPEP 706.02(j) states:

1 “[t]o establish a *prima facie* case of obviousness, three basic
2 criteria must be met. First, there must be some suggestion or
3 motivation, either in the cited references themselves or in the
4 knowledge generally available to one of ordinary skill in the art, to
5 modify the reference or to combine the reference teachings. Second,
6 there must be a reasonable expectation of success. Finally, **the prior**
7 **art reference** (or references when combined) **must teach or suggest**
8 **all the claim limitations.** The teaching or suggestion to make the
9 claimed combination and the reasonable expectation of success must
10 both be found in the prior art and not based on applicant’s disclosure.”
11 (Emphasis added.)
12

13 With respect to claims 2-11, as respectively amended, those claims depend
14 (directly or indirectly) from claim 1. Regarding claims 13-20, those claims depend
15 (directly or indirectly) from claim 12, as amended. It is axiomatic that any claim that
16 depends, directly or indirectly, from an allowable base claim is also allowable.
17 Hereinafter, the Applicant provides arguments focused on the allowability of claims 1
18 and 12 (as respectively amended). The Applicant does not believe it necessary
19 provide arguments in favor of each and every dependent claim.
20

21 Claim 1

22 The Applicant respectfully asserts that claim 1, and claims 2-11, as
23 respectively amended, that depend therefrom, are allowable. In regard to claim 1,
24 that claim recites the following features and limitations:
25

 An automated data entry method comprising:
 entering a user information at a first location;

1 searching a storage medium at said first location to determine
2 an identity of a user based on the entered information;

3 accessing a storage medium at a second location upon not
4 being able to identify a user by searching the storage medium at said
5 first location, said medium at the second location containing
6 information for a plurality of users;

7 searching the storage medium at the second location to
8 determine an identity of said user based on the entered information;
9 and

10 retrieving additional information pertaining to the user from the
11 storage medium at the first or second locations based on the
12 determined identity.

13 (Emphasis added.)
14

15 Gupta fails to teach or suggest searching a storage medium at said first
16 location to **determine an identity of a user based on the entered information**, as
17 recited in combination with the other features and limitations of claim 1. Also, and as
18 already admitted by the Examiner (page 3 of Office action), Gupta fails to teach or
19 suggest accessing a storage medium at a second location **upon not being able to**
20 **identify a user** by searching the storage medium at said first location, said medium
21 at the second location containing information for a plurality of users, and searching
22 the storage medium at the second location to **determine an identity of said user**
23 **based on the entered information**, as recited in combination with the other
24 features and limitations of claim 1. Furthermore, Gupta fails to teach or suggest
25 retrieving additional information pertaining to the user from the storage medium at
the first or second locations **based on the determined identity**, as recited in
combination with the other features and limitations of claim 1.

1 Rather, Gupta is directed to a method of automatically filling in purchaser
2 information in one or more online forms using information stored within a (single)
3 User Meta-database 170 (Abstract; Fig. 1C; and Col. 8, lines 15-67 of Gupta).
4 Gupta also teaches that each online form is identified using the URL (Uniform
5 Resource Locator, or 'web address') of that online form, such that an attribute
6 matching procedure can be employed to determine what user data from the User
7 Meta-database 170 is needed to complete that particular online form (Col. 8, lines
8 15-52 of Gupta). Importantly, Gupta provides no teachings or suggestions
9 whatsoever directed to **determining an identity of a user**, in any way. This is not
10 the same as the invention as recited by claim 1.

11 Furthermore, Gupta makes it clear that the User Meta-database 170 is the
12 **only** database (i.e., electronically accessible resource, or location) for such user
13 information as used to complete an online form or forms (Col. 8, lines 15-18 and
14 lines 59-61 of Gupta). Thus, Gupta does not teach or suggest **retrieving additional**
15 **information pertaining to the user from the storage medium at the first or second**
16 **locations based on the determined identity**, as recited in combination with the
17 other features and limitations of claim 1.

18 The Examiner has asserted that, "It would have been obvious to one of
19 ordinary skill in the art at the time the invention was made that when the user's
20 identity is not found in the local database, Gupta's form filler is able to search and
21 obtain a respective vendor's customer records for the underlying user's identity"
22 (page 3 of Office action). Respectfully, this is not a valid assertion. Specifically,
23 Gupta does not teach or suggest any method, apparatus or procedure directed to
24 ***determining an identity of a user*** in any way or for any purpose. That is, the entire
25 concept of ***determining an identity of a user*** is total ignored by Gupta. One studying
Gupta is left to presume that a user's identity is positively determined – by unknown
means - at the initial stages of each use, and that any substantially automated

1 means for making such a determination are unnecessary. Accordingly, if the
2 problem to be solved is to determine the identity of a user when the user's identity is
3 not found in the local database, then one would not be motivated to look to a
4 reference (Gupta) which (1) makes absolutely no mention of determining the identity
5 of a user, and (2) does not provide for retrieving information from a storage medium
6 at a second location for such a purpose.

7 As stated in MPEP 706.02(j), "The teaching or suggestion to make the
8 claimed combination [here, Gupta, and what was known to one of ordinary skill in
9 the art at the time the invention was made] and the reasonable expectation of
10 success must both **be found in the prior art and not based on applicant's**
11 *disclosure*. Accordingly, an assertion that one of ordinary skill in the art would look
12 to Gupta, and would then modify Gupta in the manner suggested, when seeking a
13 solution to the stated problem (i.e., determining the identity of a user) can only be
14 based on using the Applicant's claims as a roadmap, which constitutes an
15 impermissible act of hindsight reconstruction. ("The references must be viewed
16 without the benefit of impermissible hindsight vision afforded by the claimed
17 invention." MPEP § 2141.) As such, the § 103 rejection of claim 1 cannot be
18 supported by the Examiner's foregoing assertions.

19 To summarize, in the first instance, Gupta does not suggest or motivate any
20 modifications to the teachings thereof that would lead one of skill in the art toward
21 the instant invention as recited by claim 1. And, in the second instance, modifying
22 Gupta in the manner suggested in order to address the problem (of determining the
23 identity of a user), and therefore arrive at Applicant's claim 1, requires such
24 modification of Gupta as rises to the level of invention itself. This is true for at least
25 the following reasons: (1) Gupta provides no teachings, suggestions or motivations
directed to determining an identity of a user; (2) Gupta does not teach or suggest
referring to a second database for any reason; and (3) Gupta is directed to solving a

1 different problem (i.e., completing multiple online forms vs. retrieving user
2 information from plural different locations) in a different way (i.e., identifying multiple
3 online forms vs. identifying a user). Therefore, the motivation to modify Gupta in the
4 manner suggested cannot be found within Gupta itself, nor can the motivation to
5 modify Gupta in the manner suggested be found within the general knowledge of
6 one of ordinary skill in the art at the time the invention was made. The § 103
7 rejection of claim 1 is therefore invalid in view of the deficiencies of Gupta and in
8 further view of the requirements as recited by MPEP 706.02(j), and should be
9 withdrawn.

10 The Examiner is respectfully referred to MPEP 2143.01, which states that:

11 “Obviousness can only be established by combining or
12 modifying the teachings of the prior art to produce the claimed
13 invention where there is some teaching, suggestion or motivation to do
14 so found either explicitly or implicitly in the references themselves, or in
15 the knowledge generally available to one of ordinary skill in the art.”

16 MPEP 2143.01 (second paragraph) further refers to the importance of relying
17 on objective evidence and making specific factual findings with respect to a
18 motivation to modify and/or combine a reference or references. Therein lies the
19 heart of the issue at hand: the Examiner has failed to provide any objective evidence
20 or specific factual findings to support the assertion that particular modifications to the
21 teachings of Gupta would have been obvious to one of ordinary skill in the art at the
22 time of the present invention, thus leading to the invention as recited by claim 1.
23 Accordingly, any such assertion on the part of the Examiner is a matter of opinion
24 and speculation (i.e., subjective evidence), and is drawn without deference to the
25 substantive deficiencies of the prior art of record. As such, any such assertion (i.e.,
opinion or subjective evidence) is insufficient to support the § 103 rejection of
claim 1.

The Applicant believes that the following Table 1 helps to summarize at least some of the differences between the teachings of Gupta and the present invention as recited by claim 1:

TABLE 1		
<i>Feature, Limitation or Teaching</i>	Gupta	Claim 1
Determining an identity of a user	No	YES
Searching a first location and, if necessary, searching a second location to determine an identity of a user	No	YES
Retrieving additional user information from first or second locations based on the determined identity	No	YES
Identifying a particular online form by way of the corresponding URL	Yes	No
Filling out multiple online forms corresponding to various vendors when the online forms have been identified	Yes	No

In view of the facts presented in Table 1, the Applicant asserts that there is insufficient nexus between the teachings of Gupta and the limitations as recited by claim 1 to support any assertion that the teachings of Gupta render obvious the present invention as recited by claim 1. More so, it is evident by Table 1 that the removal of elements taught by Gupta, and the addition of elements to what Gupta teaches (which ultimately result in Applicant's claim 1), are so extensive (five modifications in all) that this level of modification rises to the level of invention itself (i.e., novel and non-obvious).

The Applicant therefore requests that the Examiner either (1) provide some "**objective evidence**" or "**specific factual findings**", beyond the mere unsupported assertions put forth by the Examiner at pages 3-4 of the Office action, to support the

1 assertion that particular modifications to the teachings of Gupta would have been
2 obvious to one of ordinary skill in the art at the time of the present invention, thus
3 leading to the invention as recited by claim 1, or (2) allow claim 1.

4 In view of the foregoing, the Applicant asserts that claim 1 is currently
5 allowable. It is axiomatic that claims 2-11, as respectively amended, are also
6 allowable by virtue of their dependence from allowable claim 1, as well as for their
7 own respectively patentable features and limitations.

8
9 Claim 12

10 The Applicant respectfully asserts that claim 12 (as amended), and claims
11 13-20 that depend therefrom, are allowable. In regard to claim 12, as amended, that
12 claim recites the following features and limitations:

13
14 A system comprising:

15 a first website corresponding to a vendor of products or
16 services, said first website having a storage medium containing user
17 information corresponding to a plurality of individuals;

18 a second website having a storage medium containing user
19 information corresponding to a plurality of individuals;

20 a network connecting said first and second websites; and

21 a user station connected to the network, the first website
22 comprising a software application being programmable to
23 communicate with the second website and to search and to retrieve
24 user information from the storage medium at the first and second
25 websites in response to information entered through a user interface of
the user station, wherein the software application is further
programmed to determine the identity of a user by way of matching the

1 information entered through the user interface of the user station to
2 user information contained on the respective storage mediums of the
3 first and second websites.

4 (Emphasis added).

5
6 Gupta fails to teach or suggest a software application [that] is further
7 programmed to **determine the identity of a user** by way of matching the
8 information entered through the user interface of the user station to user information
9 contained on the respective storage mediums of the first and second websites, as
10 recited in combination with the other features and limitations of claim 12, as
11 amended. More to the point, Gupta fails to teach or suggest any sort of method or
12 apparatus for determining the identity of a user, in any way. Gupta certainly does
13 not teach or suggest such a determination as made by matching entered information
14 against user information respectively contained on two different website storage
15 media, as recited, in slightly varying language, by claim 12, as amended. Thus,
16 Gupta fails to teach or suggest all of the claim limitations as recited by claim 12, as
17 amended.

18 Also, for reasons substantially analogous to the reasons set forth above in
19 regard to claim 1, modifying Gupta in the manner suggested in order to address the
20 problem (of determining the identity of a user), and therefore arrive at Applicant's
21 claim 12, requires such modification of Gupta as rises to the level of invention itself.
22 The Applicant respectfully asserts that the § 103 rejection of claim 12, as amended,
23 is invalid in view of the deficiencies of Gupta and the requirements as recited by
24 MPEP 706.02(j), and should be withdrawn.

25 For at least these reasons, the Applicant asserts that claim 12, as amended,
is allowable. It is axiomatic that claims 13-20 are also allowable by virtue of their

1 dependence from allowable claim 12, as amended, as well as for their own
2 respectively patentable features and limitations.

3
4 Summary

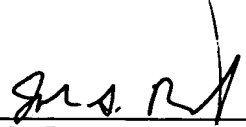
5 The Applicant believes that this response constitutes a full and complete
6 response to the Office Action. Therefore, the Applicant respectfully requests
7 reconsideration of claims 1-20, as respectively amended, in favor of timely
8 allowance.

9 The Examiner is respectfully requested to contact the below-signed
10 representative if the Examiner believes this will facilitate prosecution toward
11 allowance of the claims.

12
13 Respectfully submitted,

14 Michael J. BORG

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